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08/463,904	06/05/1995	JOSEPH B. PHIPPS	ALZ0006-00	9244
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DIEHL SERVILLA LLC 77 BRANT AVE SUITE 210 CLARK, NJ 07066			EXAMINER BOCKELMAN, MARK	
			ART UNIT 3766	PAPER NUMBER
			NOTIFICATION DATE 09/15/2008	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOSEPH B. PHIPPS

Appeal 2007-1556
Application 08/463,904
Technology Center 3700

Mailed: September 11, 2008

Before DALE M. SHAW, *Chief Appeals Administrator*
SHAW, *Chief Appeals Administrator*.

ORDER DENYING ENTRY OF REQUEST FOR REHEARING

This application was electronically received at the Board of Patent Appeals and Interferences (Board) on February 23, 2007. A Docketing Notice was mailed and Appeal No. 2007-1556 was assigned on March 15, 2007. A Notice of Oral Hearing was mailed to Appellant on February 29, 2008. Appellant, on March 17, 2008, waived the Oral Hearing. On July 1, 2008, a merits panel of the Board mailed a decision, affirming all the

grounds of rejection on appeal. The Grounds of Rejection that were affirmed are:

- 1) Claims 1, 4, and 7-9 under 35 U.S.C. § 103 as obvious over Phipps '739 (U.S. Pat. No. 5,423,739, issued Jun. 13, 1995) in view of Rebinder (Chapter 12, Iontophoresis, in *Electrokinetischeskie kapillarnykh system: monographicheskii sbornik*, Editor: Rebinder, Moscow USSR Academy of Science, 1956, pp. 310-327; translation presented as pp. 1-31), Phipps '894 (U.S. Pat. No. 5,125,894, issued Jun. 30, 1992), and Muller (U.S. Pat. No. 5,320,731, issued Jun. 14, 1994) (Ans. 5);
- 2) Claims 1, 4, and 7-9 under 35 U.S.C. § 102(b) as anticipated by Haak (U.S. Pat. No. 5,203,768, issued Apr. 20, 1993), or in the alternative, under 35 U.S.C. § 103(a) as obvious over Haak in view of Rebinder, Phipps '894, Muller, or in view of Newman (U.S. Pat. No. 4,931,046, issued Jun. 5, 1990) (Ans. 13);
- 3) Claims 1, 4, and 7-9 under 35 U.S.C. § 102(b) as anticipated by Theeuwes (U.S. Pat. No. 5,232,438, issued Aug. 3, 1993), or in the alternative, under 35 U.S.C. § 103(a) as obvious over Theeuwes in view of Rebinder, Phipps '894, Muller, or in view of Newman (Ans. 15).
- 4) Claims 1, 4, and 7-9 under the judicially created doctrine of double-patenting as obvious over Claims 1-9 of Southam (U.S. Pat. No. 6,171,294 B1, issued Jan. 9, 2001) (Ans. 16).

It is noted that the merits panel considered the decision as an affirmance. The panel's decision does not indicate that a new ground of rejection was entered, as permitted by 37 C.F.R. § 41.50(b).

On August 7, 2008, Appellant filed a response, entitled "Request for Reconsideration Under 37 C.F.R. § 41.50(b) (1) and 37 C.F.R. § 1.198." It

is noted that 37 C.F.R. § 41.50(b)(1) sets forth the requirements for reopening prosecution following entry of a new ground of rejection. Appellant's response contains a proposed amendment to claim 1 and arguments as to why the amended claim is allowable over the affirmed rejections.

Since the Board decision dated July 1, 2008 did not set forth a new ground of rejection under 37 C.F.R. §41.50(b), Appellant did not have the option of filing a Request for Rehearing under 37 C.F.R. §41.50(b) (1), but only under 37 C.F.R. § 41.52. Since appellant filed the Request for Rehearing under 37 C.F.R. § 41.50(b) (1), including a proposed amendment of the claims, and not under § 41.52, the Request for Rehearing filed August 7, 2008 must be treated as an improper Request for Rehearing. Therefore, the Request for Rehearing filed August 7, 2008 is denied entry, and the application will be returned to the Technology Center for final disposition.

Accordingly, it is

ORDERED

(1) that the Request for Rehearing filed August 7, 2008 is denied entry,

(2) that the application be returned to the Technology Center for final disposition, and

(3) for such further action as may be appropriate.

If there are any questions pertaining to this order, please contact the Board of Patent Appeals and Interferences at 571-272-9797.

Appeal 2007-1556
Application 08/463,904

DMS/clj

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